

## REMARKS

In summary, claims 1-10 and 15-22 are pending. Claims 1, 10, 15, and 21 are independent. Claim 21 is hereby amended without adding new matter. A rejection of claims 21 and 22 under 35 U.S.C. § 101 is repeated. A rejection of claims 1-10 and 15-22 under 35 U.S.C. § 102 is repeated. Reconsideration of the application in view of the foregoing amendments and following remarks is respectfully requested.

### Telephone Conversation With Examiner

Examiner Vu is thanked for the telephone conversation conducted on September 2, 2008. Examiner Vu was asked to change the date of the “RDC9” reference, as reflected on the form PTO-892 from 5/14/2000 5/14/2003. Examiner Vu agreed to look into this issue and correct the date if warranted. Evidence needed to support a 37 C.F.R. § 1.131 declaration was discussed. Examiner Vu stated that he needed evidence of some activity during the time period between the date of the reference (5/14/2003) and the date of constructive reduction to practice (6/20/2003).

### Rejection of Claims 21, 22 under 35 U.S.C. § 101

Claims 21 and 22 are rejected under 35 U.S.C. § 101 for allegedly claiming non-statutory subject matter. (Office Action, pp. 2-3). Specifically, the Office Action argues that claims 21 and 22 are mere listings of functional descriptive material (i.e., purely abstract) even though the claims are for a “computer system . . . comprising means for [performing functions].” The Office Action argues that the claimed “computer system” “[does] not explicitly includ[e] a computer or processor hardware.” The Office Action argues that the claimed “computer system” is “devoid of any hardware support or tangible apparatus to carry out or realize the functionality of any software entity being claimed.” (Office Action, p. 2). Applicants traverse the rejection.

It is respectfully submitted that the Examiner misinterprets the claims inconsistent with the specification and misinterprets patent law pertaining to 35 U.S.C. § 101, on which MPEP §§ 2106 and 2107 are based. Regardless, without prejudice or disclaimer as to whether claims 21

and 22 are directed to statutory subject matter, claim 22 is amended to recited “a processor.” Accordingly, reconsideration and withdrawal of the rejection of claims 21 and 22 under 35 U.S.C. § 101 is respectfully requested.

**Rejection of Claims 1-10 and 15-22 under 35 U.S.C. § 102(a)**

Despite receiving a declaration pursuant to 37 C.F.R. § 1.131, the Examiner repeats the rejection of claims 1-10 and 15-22 under 35 U.S.C. § 102(a) as being unpatentable over a publication entitled “Report Designer Component 9 – Creating a RDC Deployment Package,” pp. 1-17, published May 14, 2003 (hereinafter referred to as “RDC9”). Applicants again respectfully traverse the rejection.

Applicants repeat that the RDC9 indicates a date of 5/14/2003 and recites “Copyright © 2003”. Applicants again request that the form PTO-892 be corrected to accurately reflect a date of 5/14/2003.

Applicants continue to contend that RDC9 is not prior art. The pending application was filed on June 20, 2003, only 37 days after RDC9 was published May 14, 2003. In compliance with 37 C.F.R. § 1.131, attached to the previous Reply of May 2, 2008 is an inventor declaration with redacted copies of documents together showing that the claimed invention was conceived prior to May 14, 2003 and that the inventors engaged in “reasonable diligence” to constructively reduce the invention to practice (*i.e.*, by waiting for the preparation and filing of the patent application and accompanying documents, reviewing and signing when requested) from just prior to May 14, 2003 to the filing date of June 20, 2003, which is the only time diligence need be shown, per MPEP 715.07(a). “Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (*i.e.*, filing a United States patent application.”).

In the 38 days from just before May 14, 2003 to June 20, 2003, the inventors collaborated when necessary with patent attorneys to prepare the patent application and accompanying documents. One specific example of this collaboration has been of record since June 20, 2003. The

oath of record shows that inventor Haselden signed the oath June 17, 2003 while inventor Sharma signed it June 19, 2003. Other acts by the inventors during this 38 day time period involve attorney-client privileged communications between the inventors and their legal representatives, which privilege is not waived.

While “the actual dates of acts relied on to establish diligence must be provided” per MPEP 715.07 II, diligence in this case “relates to reasonable ‘attorney-diligence’ and ‘engineering-diligence,’ which does not require that ‘an inventor or his attorney . . . drop all other work and concentrate on the particular invention involved.’” MPEP 2138.06 (citations omitted). “An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity . . .” MPEP 715.07(a). “Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient.” MPEP 2138.06 (citations omitted).

Having elected not to disclose specific dates in accordance with MPEP 715.07 II, the inventors state in the declaration that, “we hereby declare that we invented the subject matter of the pending claims prior to May 14, 2003. We further hereby declare that we worked diligently from a date prior to May 14, 2003 to the date of constructive reduction to practice, June 20, 2003, the filing date of the [pending] application, in order to prepare the [pending] application.” Declaration of Inventors Haselden and Sharma, April 25, 2008, ¶ 4.

The Office Action dismisses the declaration and maintains the rejection by arguing that the declaration and accompanying documents are not sufficient to show diligence in the 38 days from just before May 14, 2003 to June 20, 2003. (Office Action, p. 9 (“evidence is deemed insufficient to convincingly establish factual diligent work”)). More specifically, the Office Action demands “factual evidences showing that dated work was sustained [and] daily distributed in a more or less continuous manner between prior to 5/14/03 up to 06/20/03.” (Office Action, p. 9).

As previously set forth, this demand in the Office Action, as the basis for dismissing the declaration and maintaining the rejection, is without merit according to the MPEP and the law on which it is based. It is of record that inventors were diligent during the 38 day period at issue by reviewing and signing patent application related documents when requested, which is also shown by the oath (executed June 17 and 19, 2003 by the inventors) that has been of record since June 20, 2003. "Diligence must be judged on the basis of the particular facts in each case." (MPEP 1715.07(a)).

Further, per Examiner's request during the foregoing described telephone conversation, a redacted copy of an invoice showing activity during the time period just prior to May 14, 2003 to June 20, 2003 is submitted. The submitted invoice has been redacted to remove unnecessary business-related information that is not pertinent to the claimed subject matter.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-10 and 15-22 under 35 U.S.C. § 102(a) is respectfully requested.

Any amendments made during prosecution of the pending application are without abandonment of subject matter. Applicants expressly reserve the right to, in the pending application or any application related thereto, reintroduce any subject matter removed from the scope of claims by any amendment and introduce any subject matter not present in current or previous claims.

**DOCKET NO.:** MSFT-1741-301923.01  
**Application No.:** 10/600,178  
**Office Action Dated:** July 15, 2008

**PATENT**

### **CONCLUSION**

In view of the foregoing amendments and remarks, including the attached declaration, it is respectfully submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are respectfully requested.

Date: October 9, 2008

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